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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,526	02/17/2006	Nikolai (Mykola) Ignatyev	MERCK-3134	5082

23599 7590 08/24/2009  
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ARLINGTON, VA 22201

EXAMINER
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POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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08/24/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,526	<b>Applicant(s)</b> IGNATYEV ET AL.	
	<b>Examiner</b> Fiona T. Powers	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/20/09, 4/28/09, 8/13/09.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,5-19,27 and 29-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,20,28 and 41-44 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/17/06</u> . | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group 10, claims 1, 4, 20-26 and 28 where  $CAT^+$  is polymethine and  $Y^-$  is of the formula II-2 in the reply filed on April 20, 2009 and August 13, 2009 is acknowledged. The traversal is on the ground(s) that the examination of related groups together will not impose an undue burden on the Examiner. This is not found persuasive because as set forth in the restriction requirement, the search of all of the Groups would impose an undue burden on the examiner and the patent office resources because separate patent, literature and computer searches would need to be done. It is impossible to search for all of the dye cations and anions set forth in the claims in a single computer search, for example.

The requirement is still deemed proper and is therefore made FINAL.

Claims 2, 3, 5-19, 27 and 29-40 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 20, 2009 and August 13, 2009.

### ***Claim Objections***

Claims 1, 4, 20-26, 28 and 41-44 are objected to because of the following informalities: the claims contain non-elected subject matter. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 20, 28 and 41 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman et al. (US 5876821), cited in view of Sartori et al. (US 6210830) or Heider et al. (US 6423454), cited.

#### **Determination of the scope and content of the prior art (MPEP §2141.01)**

Chapman et al. discloses structurally similar polymethine cyanine dyes that are useful in optical recording elements. The dyes of the reference are structurally similar to the claimed dyes of the formula (I) where  $CAT^+$  is a polymethine cation and  $Y^-$  is  $FAP^-$ , a fluoroalkylphosphate anion which is of the formula (II-2). Note Dye B-3 in column 17.

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Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The dye B-3 of Chapman et al. differs from those claimed in that the anion is a hexafluorophosphate anion instead of a fluoroalkylphosphate anion.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

Sartori et al. and Heider et al. disclose fluoroalkylphosphate salts and their use as electrolyte salts. Sartori and Heider disclose that fluoroalkylphosphate salts are superior to hexafluorophosphate salts. For example, they are resistant to hydrolysis in aprotic polar solvents, have excellent solubility in said solvents and are extremely stable. Note column 4, line 37 to column 5, line 35 of Sartori and column 1, line 53 to column 2, line 31, column 7, lines 33 to line 45, Example 1 and Table 3 of Heider et al.

One of ordinary skill in the art would have been motivated to make the claimed polymethine dyes by substituting the fluoroalkylphosphate anion of Sartori or Heider for the hexafluorophosphate anion in the dyes of Chapman et al. with the expectation that additional dyes useful in optical recording elements with greater stability would be obtained.

The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fiona T. Powers/  
Primary Examiner, Art Unit

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August 17, 2009